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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/690,295

10/21/2003

Murray S. Toas

D0932-00339

2364

8933 7590 03/22/2007
DUANE MORRIS, LLP
IP DEPARTMENT
30 SOUTH 17TH STREET
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EXAMINER

SPAHN, GAY

ART UNIT

PAPER NUMBER

3635

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/22/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/690,295	TOAS ET AL.	
	Examiner	Art Unit	
	Gay Ann Spahn	3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2003 and 15 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 2,6-14 and 16-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,15,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>21 October 2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of SPECIES IV (i.e., Fig. 4) from the FIRST GROUP OF SPECIES, SPECIES II (i.e., layer 20 divided into two sections) from the SECOND GROUP OF SPECIES, and SUBSPECIES I based on SPECIES II OF THE SECOND GROUP OF SPECIES in the reply filed on 15 February 2007 is acknowledged.

Claims 2, 6-14, and 16-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 15 February 2007.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 21 October 2003 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

However, the examiner notes that the fourteenth listed item (i.e., U.S. Patent No. 4,756,495) in the "U.S. Patent Documents" section has been lined through as not being considered because U.S. Patent No. 4,756,495 is a patent to Putnam, not a patent to Gibb.

Further, in the "Foreign Patent Documents" section the second, third, fourth, and fifth listed items (i.e., DE3118597A1, DE3229601A1, DE4108110A1, and DE4435317A1, respectively) on page 1 of 3 and the fifth and sixth listed items (i.e., WO98/42930 and WO01/63063A1, respectively) have all been lined through as not being considered. DE3118597A1 and DE3229601A1 have not been considered because applicant failed to supply of copy of the foreign patent as required by 37 CFR 1.98(a)(2)(i). DE4108110A1 and DE4435317A1 have not been considered because Applicant failed to include a concise explanation of the relevance of the non-English language document as is required by 37 CFR 1.98(a)(3)(i). WO98/42930 and WO01/63063A1 have not been considered because Applicants did not file a copy of the complete foreign patent (i.e., only the Abstract (in both French and English) and the drawings of WO98/42930 and only the Abstract (in both German and English) in WO01/63063A1) as is required by 37 CFR 1.98(a)(2)(i).

Finally, in the "Non Patent Literature Document" section the last three listed items (i.e., Gullfiber M-Skiva, Johns Manville, Easy Fit, and Johns Manville, Formaldehyde-free) have all been lined through as not being considered. The Gullfiber M-Skiva reference was not considered because Applicant failed to include a concise explanation of the relevance of the non-English language document as is required by 37 CFR 1.98(a)(3)(i). The Johns Manville, Easy Fit and Johns Manville, Formaldehyde-free documents were not considered because they have no publication date as is required by 37 CFR 1.98(b)(5).

Drawings

The drawings are objected to because:

(1) Fig. 1, the "Fig. 2" within the fibrous insulation material is barely perceptible and therefore the lead line should be extending so that "Fig. 2" is under the figure similar to reference numerals "30" and "34";

(2) Figs. 1 and 3, the line under reference numeral "10" should be deleted since it is only appropriate to put a line under a number if the number is located on the structure it represents and a lead line ending in arrow should be extended from reference numeral "10" toward the structure it represents;

(3) Fig. 3, an exploded view should have a bracket embracing the separated parts in accordance with 37 CFR 1.84(h)(1);

(4) Figs 1, 3, 5, 6A, 7, 8A, 8B, 9B, 10A, and 10B, the use of arrows at the end of lead lines is noted and it is not clear that the arrows comply with 37 CFR 1.84(r)(1) and any arrows that are not compliant with 37 CFR 1.84(r)(1) should be deleted;

(5) Fig. 9A, reference numeral "50" should be changed to --58--; and

(6) the Manual of Patent Examining Procedure (MPEP) § 608.01(g), entitled "Detailed Description of Invention," states that "reference characters must be properly applied, no single reference character being used for two different parts or for a given part and a modification of such part" and the MPEP suggests using prime symbols to differentiate between a given part and its modification (however, since there are eight different species of the separation means in the present application, the examiner

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suggests that instead of using prime symbols, Applicants adopt another commonly used convention of increasing by 100 for each embodiment).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

(1) page 8, line 2 of paragraph no. [0034], reference characters "40a-d" should be changed to --400a-d--.

Appropriate correction is required.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. More particularly, the examiner suggests amending the title of the invention to indicate the patentable feature of the invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1, 3-5, 15, 19, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, lines 5-6, the recitation of “wherein at least a first inner sidewall of a first insulation layer section has applied thereto an adhesive for adhering to an adjacent second inner sidewall of a second adjacent insulation layer section” is vague, indefinite, and confusing as lacking antecedent basis since it is not clear if “a first insulation layer section” and “a second adjacent insulation layer section” are referring back to the “adjacent layer sections” formed by the cut and introduced on line 4 or if they are in addition thereto.

Further, it is not clear if the “at least a first inner sidewall” and “an adjacent second inner sidewall” are referring back to the “at least one inner sidewall” of each adjacent layer section that was introduced in lines 4-5 or if the first and second inner sidewalls are in addition thereto.

Claim 3, line 2, the recitation of “respective insulation layer sections” is vague, indefinite, and confusing as lacking antecedent basis since it is not clear if this is referring back to the adjacent layer sections introduced in line 4 of claim 1, or the first insulation section and the second adjacent insulation layer sections introduced in lines 5 and 6-7, respectively, in claim 1, or are in addition thereto.

Claim 15, lines 1-2, the recitation of “wherein the fibrous insulation layer includes two layer sections, one layer section having a width of 4 inches and one layer section having a width of 11 inches” is vague, indefinite, and confusing as lacking antecedent basis since it is not clear if “two layer sections” refers back to adjacent layer sections introduced in line 4 of claim 1, or the first insulation section and the second adjacent insulation layer sections introduced in lines 5 and 6-7, respectively, in claim 1, or are in addition thereto.

Further, it is not clear if the second recitation of “one layer section” in line 2 is a different layer section from the first recitation of “one layer section” in line 2 and if the first and second recitation of “one layer section” is referring back of the two layer sections introduced in lines 1-2, or adjacent layer sections introduced in line 4 of claim 1, or the first insulation section and the second adjacent insulation layer sections introduced in lines 5 and 6-7, respectively, in claim 1, or are in addition thereto.

Claim 19, line 4, the recitation of “a fibrous layer” is vague, indefinite, and confusing as lacking antecedent basis since it is not clear if this is referring back to the fibrous insulation layer introduced in line 2 or is in addition thereto.

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Claim 19, lines 5 and 6, the first and second recitation of “the fibrous layer”, respectively, is vague, indefinite, and confusing as lacking antecedent basis since it is not clear if this is referring back to the fibrous layer introduced in line 4 or the fibrous insulation layer introduced in line 2.

Claim 19, line 8, the recitation of “the said sections” is vague, indefinite, and confusing and the examiner suggests deleting either on of “said” to “the”.

Claim 19, line 9, the recitation of “at least first or second major surfaces” is vague, indefinite, and confusing as lacking antecedent basis and the examiner suggests amending to --at least one of said first major surface or said second major surface--.

Claim 19, lines 9-10, the recitation of “a fibrous layer” is vague, indefinite, and confusing as lacking antecedent basis since it is not clear if this is referring back to the fibrous insulation layer introduced in line 2 or the fibrous layer introduced in claim 4.

Claim 20, lines 6-7, the recitation of “wherein at least a first inner sidewall of a first insulation layer section has applied thereto an adhesive for adhering to an adjacent second inner sidewall of a second adjacent insulation layer section” is vague, indefinite, and confusing as lacking antecedent basis since it is not clear if “a first insulation layer section” and “a second adjacent insulation layer section” are referring back to the “adjacent insulation layer sections” formed by the cut and introduced on line 5 or if they are in addition thereto.

Further, it is not clear if the “at least a first inner sidewall” and “an adjacent second inner sidewall” are referring back to the “at least one inner sidewall” of each

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adjacent insulation layer section that was introduced in lines 5-6 or if the first and second inner sidewalls are in addition thereto.

Claim 20, line 12, the recitation of “at least one longitudinal cut” is vague, indefinite, and confusing as lacking antecedent basis and the examiner suggests amending to --said at least one longitudinal cut--.

Claim 20, line 13, the recitation of “the respective separation means” is vague, indefinite, and confusing as lacking antecedent basis since only one separation means has been introduced in line 10.

Claim 20, line 14, the recitation of “separate insulation blanket sections” is vague, indefinite, and confusing since it is not clear if or how the insulation blanket sections differ from the adjacent insulation layer sections introduced in line 5, and the first insulation layer section introduced in lines 6-7, and the second adjacent insulation section introduced in line 8.

Claim 20, line 15, the recitation of “a first separate insulation blanket section” is vague, indefinite, and confusing as lacking antecedent basis since it is not clear if this is one of the separate insulation blanket sections introduced in line 14 or is in addition thereto.

Claim 20, line 15-16, the recitation of “a non-standard sized cavity” is vague, indefinite, and confusing as lacking antecedent basis since it is not clear if this is referring back to the cavity recited in line 1 or not.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-5, 19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by ALLWEIN ET AL. (U.S. Patent No. 6,935,080).

As to claim 1, ALLWEIN ET AL. disclose an insulation blanket (420 in Figs. 37-39) comprising:

a fibrous insulation layer (420) having a first major surface (432) and a second major surface (430), and at least one longitudinal cut (434) extending from said first major surface (432) to said second major surface (430), said cut (434) forming adjacent layer sections (440, 442) each having at least one inner sidewall (unnumbered, but right sidewall of 440 and left sidewall of 442), and wherein at least a first inner sidewall (unnumbered, but right sidewall of 440) of a first insulation layer section (440) has applied thereto an adhesive (448) for adhering to an adjacent second inner sidewall (unnumbered, but left sidewall of 442) of a second adjacent insulation layer section (442); and

a facing material (450) disposed on said first major surface (432), said facing material (450) having separation means (tab 460) which extends substantially along said at least one longitudinal cut (434).

As to claim 3, ALLWEIN ET AL. disclose the insulation blanket of claim 1 as discussed above, and ALLWEIN ET AL. also disclose that the facing material (450) comprises separate facing sheets (472, 472) each adhered to respective insulation layer sections (440, 442), and wherein the separation means (460) includes an overlap area (left end of left 472 over 440 and right end of right 472 over 442) of the separate facing sheets (472, 472).

As to claim 4, ALLWEIN ET AL. disclose the insulation blanket of claim 3 as discussed above, and ALLWEIN ET AL. also disclose that the overlap area (left end of left 472 over 440 and right end of right 472 over 442) is approximately 1/4 - 1 inch in width (see col. 16, lines 23-24, wherein it states the tabs are preferably 3/8th of an inch to about 1-1/2 inch).

As to claim 5, ALLWEIN ET AL. disclose the insulation blanket of claim 3 as discussed above, and ALLWEIN ET AL. also disclose that the facing sheets (472, 472) include a fastening tab (458 - see Fig. 37) on one or both side edges.

As to claim 19, ALLWEIN ET AL. disclose a method of making a faced separable insulation blanket (420 in Figs. 37-39) comprising:

providing a fibrous insulation layer (420) having first and second major surfaces (432, 430) thereon,

cutting a fibrous layer (420) into separate layer sections (440, 442) by making at least one longitudinal cut (434) that extends from said first major surface (432) of the fibrous layer (420) to said second major surface (430) of the fibrous layer (420),

applying an adhesive (448) to one or more inner sidewalls (unnumbered, but right sidewall of 440 and left sidewall of 442) of said separate layer sections (440, 442) to glue the said sections (440, 442) together, and

applying a facing material (450) to at least first or second major surface (432, 430) of the fibrous layer (420), wherein the facing material (450) includes separation means (460) that is substantially aligned with the at least one longitudinal cut (434).

As to claim 20, ALLWEIN ET AL. disclose a method of insulating a cavity in a framework of a building comprising:

(a) providing an insulation blanket (420) including:

a fibrous insulation layer (420) having a first major surface (432) and a second major surface (430), and at least one longitudinal cut (434) extending from said first major surface (432) to said second major surface (430), said cut (434) forming adjacent insulation layer sections (440, 442) each having at least one inner sidewall (unnumbered, but right sidewall of 440 and left sidewall of 442), wherein at least a first inner sidewall (unnumbered, but right sidewall of 440) of a first insulation layer section (440) has applied thereto an adhesive (448) for adhering to an adjacent second inner sidewall (unnumbered, but left sidewall of 442) of a second adjacent insulation layer section (442); and

a facing material (450) disposed on said first major surface (432), said facing material (450) having a separation means (460) which extends substantially along said at least one longitudinal cut (434),

(b) separating the insulation blanket (420) along at least one longitudinal cut (434) of the fibrous insulation layer (420) and the respective separation means (460) of the facing material (450) to form separate insulation blanket sections (440, 442); and

(c) inserting a first separate insulation blanket section (440) into a non-standard sized cavity in the framework of the building (see col. 2, lines 38-52 and col. 4, lines 1-12).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over ALLWEIN ET AL. (U.S. Patent No. 6,935,080).

As to claim 15, ALLWEIN ET AL. disclose the insulation blanket of claim 1 as discussed above, and ALLWEIN ET AL. also disclose that the fibrous insulation layer (420) includes two layer sections (440, 442 - see col. 15, lines 11-17, wherein it states that a two-section embodiment is contemplated).

ALLWEIN ET AL. does not explicitly disclose that one layer section has a width of 4 inches and one layer section has a width of 11 inches.

However, it is well settled that changes in size/proportion (i.e., dimension) does not constitute a patentable difference. See *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.). See also, *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

It would have been an obvious expedient to one of ordinary skill in the art at the time the invention was made to modify the insulation blanket of ALLWEIN ET AL. by making one of the sections be 4 inches wide and the other section be 11 inches wide in order to easily accommodate obstructions in the typical approximately 14-1/2 inch spacing between framing members in conventional residential housing structures.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Patents cited of interest as showing various configurations of insulation blankets include: U.S. Patent No. 3,048, 513 to Hughes; U.S. Patent Application Publication No. 2004/0055227 and U.S. Patent No. 6,141,930 both to Allwein et al.; U.S. Patent Application Publication No. 2003/0175466 and U.S. Patent No. 6,743,326 both to Bogrett et al.; and U.S. Patent No. 4,025,680 to Botsolas et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gay Ann Spahn whose telephone number is (571)-272-7731. The examiner can normally be reached on Monday through Friday, 10:30 am to 7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (571)-272-6842. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

^{GAS}
Gay Ann Spahn, Patent Examiner
March 18, 2007

Robert Canfield
Primary Examiner

A handwritten signature in black ink, appearing to be 'RC', written over the printed name of the Primary Examiner.